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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,308	03/27/2001	Mathieu Hubertus M. Noteborn	4820US	4047

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EXAMINER

WOITACH, JOSEPH T

ART UNIT PAPER NUMBER

1632

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/819,308

**Applicant(s)**

NOTEBORN ET AL.

**Examiner**

Joseph T. Voitach

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15, 16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

This application filed March 27, 2001 claims benefit to foreign application 00201108.8 filed March 27, 2000 with European Patent Office.

Applicants' amendment filed April 9, 2004, has been received and entered. Claims 15 and 19 have been amended. Claims 15, 16, 19, 20 and 21 are pending and currently under examination.

### ***Election/Restriction***

Applicant's election with traverse of Group VIII, directed to a method of inducing apoptosis in a cell or in a subject comprising administering a polynucleotide set forth in SEQ ID NO: 1 or SEQ ID NO: 9 was acknowledged. Groups VII and VIII were rejoined because it was Examiner indicated that a search of SEQ ID NO: 9 would identify partial sequences as encompassed by SEQ ID NO: 1, and thus, would not constitute an undue burden. Applicant timely traversed the restriction (election) requirement in Paper No. 9. The requirement is still deemed proper and is therefore made FINAL.

Claims 15, 16 and 19-21 are pending and currently under examination as they are drawn to a method of inducing apoptosis in a cell or a subject by administering either SEQ ID NO: 1 or SEQ ID NO: 9.

Applicant is reminded that upon the cancellation of a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 16, 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 15 and 19 are vague and unclear in the recitation of “or recombinant nucleic acid” because the metes and bounds of what is encompassed by the term “recombinant” is not clearly set forth in the claim nor the specification. It is unclear if the claims encompass simply an isolated sequence and the term ‘recombinant’ is redundant, or if it encompasses other types of modifications to the primary sequence set forth in SEQ ID NOs: 1 or 9. If the term is in reference to modifications of a given sequence, it is unclear how altered and modified a sequence can become when it is a recombinant sequence, in particular because there is no specific property of the encoded protein recited or required by the claims. The specification does not set forth a definition for the term “recombinant” nor provide examples of what would be considered a recombinant sequence except in the context of the sequences in a vector. Deleting the term or more clearly setting forth the metes and bounds of ‘recombinant’ would address the basis of the rejection.

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Dependent claims 16, 20 and 21 are included in the basis of the rejection because they fail to address how a polynucleotide alone would result in the affect of practicing the method asset forth in the preamble.

***Conclusion***


The claims are free of the art of record. Claims 15, 16 and 19-21 are free of the art of record however they are subject to other rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach

  
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